

elongated envelope, and

Al forming at least one stop on the diagonal zone of weakness which protects the zone of weakness from inadvertently parting.

67. (Amended) A garment protector comprising:

a sealed envelope to enclose a folded garment or textile, said envelope having a front side and a back side,

AT at least one zone of weakness on either one or both sides along which said sealed envelope may be parted to facilitate separating the garment protector from the enclosed garment or textile, and

at least one stop on the zone of weakness which protects the zone of weakness from inadvertently parting.

REMARKS

Claims 1-67 are pending in this application. Claims 1-67 are rejected. Applicant has amended claims 1-7, 52, 55, 59, 63 and 67 and deleted claims 17, 23, 29, 35, 41, 46, and 51.

Applicant respectfully requests reconsideration of the application in view of the above amendments and the following remarks.

Objections to Drawings

The drawings were objected to under 37 CFR 1.83(a) as not illustrating every feature of the invention specified in the claims. Applicant has instructed a draftsperson to amend Figure 3 to illustrate that the zone of weakness may comprise a strip of material which is less resistant to tearing than the adjacent material, as recited in original claims 12, 20, 26, 32, 38 and 43 and on page 7, lines 10-12 of the specification. Applicant has also amended the second paragraph on

page 8 to describe the amended Figure 3. Applicant respectfully asserts that no new matter has been added to the specification.

Applicant, therefore, respectfully requests reconsideration and withdrawal of the objection under 37 CFR 1.83(a).

Rejection Under 35 U.S.C. 112, Second Paragraph

Claims 17 and 56-58, 60-62 and 64-66 were rejected under 35 U.S.C 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

With respect to claim 17, the Examiner asserts that claim 17 lacks proper antecedent basis with respect to claim 1. Applicant has amended claim 1 to include the limitation of claim 17, and has consequently cancelled claim 17.

With respect to claims 56-68, 60-62 and 64-66, the Examiner asserts that it is unclear how the Applicant “considers the specific methods claimed in claims 56-58, 60-62 and 64-66 to further limit the structure of the zone of weakness recited in claims 1, 53 and 54.” See Office Action at page 2. Applicant has amended claims 55, 59 and 63 to clearly define the method steps for fabricating Applicant’s claimed garment protector. Applicant, therefore, respectfully asserts that claims 56-58, 60-62 and 64-66, further limit the method of fabricating the garment protector of the claimed invention as recited in claims 55, 59 and 63.

Applicant, therefore, respectfully requests reconsideration and withdrawal of the rejection under 35 U.S.C 112, second paragraph.

Rejections Under 35 U.S.C. 102(b)

Claims 1-3, 10-12, 15, 16, 19, 22, 25, 28 and 55 were rejected under 35 U.S.C. 102(b) as

being anticipated by Sachs (U.S. Patent No. 1,981,571), cited by Applicant.

Applicant respectfully asserts that Sachs does not teach or disclose the subject matter recited in amended claims 1-3 and 55. Applicant has amended claims 1, 2 and 3 to include the limitation of claims 17, 23, and 29, respectively, and has consequently cancelled claims 17, 23, and 29. Applicant has amended claim 55 to recite the method steps for fabricating Applicant's claimed garment protector.

Referring to Figure 1, page 7 lns. 19-22, and page 8 lns. 1-2 of the specification, by way of example only, Applicant's claimed garment protector includes at least one stop on the zone of weakness. The stop, which is an area that is fully intact and is not part of the zone of weakness, protects the zone of weakness from inadvertently parting.

Sachs, on the other hand, does not teach or disclose a garment protector with "at least one stop on the zone of weakness which protects the zone of weakness from inadvertently parting," as recited in amended claims 1, 2, and 3. Thus, amended claims 1, 2 and 3 are allowable over the cited reference.

Similarly, Sachs does not teach or disclose a method of fabricating a garment protector by "forming at least one stop on the zone of weakness which protects the zone of weakness from inadvertently parting." Thus, amended claim 55 is allowable over the cited reference.

Claims 10-12, 15 and 16 depend from claim 1. Therefore, claims 10-12, 15 and 16 include all of the limitations of claim 1. Because claim 1 is patentable over the cited art, it follows that claims 10-12, 15 and 16 are also patentable for at least similar reasons, based on their dependency and the limitations within the claims.

Claims 19 and 22 depend from claim 2. Therefore, claims 19 and 22 include all of the

limitations of claim 2. Because claim 2 is patentable over the cited art, it follows that claims 19 and 22 are also patentable for at least similar reasons, based on their dependency and the limitations within the claims.

Claims 25 and 28 depend from claim 3. Therefore, claims 25 and 28 include all of the limitations of claim 3. Because claim 3 is patentable over the cited art, it follows that claims 25 and 28 are also patentable for at least similar reasons, based on their dependency and the limitations within the claims.

Claims 57-58 depend from claim 55. Therefore, claims 57-58 include all of the limitations of claim 55. Because claim 55 is patentable over the cited art, it follows that claims 57-58 are also patentable for at least similar reasons, based on their dependency and the limitations within the claims.

Applicant, therefore, respectfully requests reconsideration and withdrawal of the rejection of claims 1-3, 10-12, 15, 16, 19, 22, 25, 28 and 55 under §102(b).

Claim 5 was rejected under 35 U.S.C. 102(b) as being anticipated by Lim (U.S. Design Patent No. D422,903), also cited by Applicant.

Applicant respectfully asserts that Lim does disclose the subject matter recited in amended claim 5. Applicant has amended claim 5 to include the limitation of claim 41 and has consequently cancelled claim 41.

As presented in the arguments above, and referring to Figure 4, by way of example only, Applicant's claimed garment protector includes at least one stop on the diagonal zone of weakness. The stop, which is an area that is fully intact and is not part of the zone of weakness, protects the zone of weakness from inadvertently parting.

Lim, on the other hand, does not teach or disclose a garment protector with "at least one stop on the diagonal zone of weakness which protects the zone of weakness from inadvertently parting", as recited in amended claim 5. Thus, amended claim 5 is allowable over the cited reference.

Applicant, therefore, respectfully requests reconsideration and withdrawal of the rejection of claim 5 under §102(b).

Rejections Under 35 U.S.C. 103(a)

Claims 4, 6, 7, 31, 34, 45, 48 and 50 were rejected under 35 U.S.C. 103(a) as being unpatentable over Sachs in view of Lim or La Rosa (U.S. Patent No. 2,839,183), all cited by Applicant.

Claims 8, 9, 13, 14, 18, 21, 24, 27, 30, 33, 36, 39, 42, 44, 47 and 49 were rejected under 35 U.S.C. 103(a) as being unpatentable over Sachs in view of Lim or LaRosa and further in view of Gilchrist (U.S. Patent No. 4,957,203).

Claims 37 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sachs in view of Lim.

Claims 17, 23, 29, 35, 41, 46, 51 and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sachs in view of Lim or LaRosa and further in view of DeMatteis et al. (U.S. Patent No. 5,497,884).

Claims 12, 20, 26, 32, 38 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sachs in view of Lim or LaRosa and further in view of Guckenberger (U.S. Patent No. 5,158,499).

Claims 53, 54 and 59 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Sachs in view of Lim or LaRosa and Gilchrist and further in view of DeMatteis et al.

Claim 63 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 54 above, and further in view of Venturini (German Patent Application No. 4,311,841).

Claims 56, 58, 60, 62, 64 and 66 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claims 55, 59 and 63 above, and further in view of Chester (U.S. Patent No. 5,655,653).

Claims 57, 61 and 65 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claims 55, 59 and 63 above, and further in view of Guckenberger.

Claims 67 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schmidt et al. (U.S. Patent No. 5,380,094).

Applicant respectfully asserts that neither Sachs, Lim, LaRosa, DeMatteis et al., nor any other reference cited, discloses, individually or in combination, the subject matter recited in amended claims 1-7 and in claims 53, 54. Applicant has amended claim 1-7 to include the limitation of claims 17, 23, 29, 35, 41, 46, and 51 respectively, and has consequently cancelled claims 17, 23, 29, 35, 41, 46, and 51.

Referring to Figures 1, 2, 3, 4, page 7 lns. 19-22, and page 8 lns. 1-2 of the specification, by way of example only, Applicant's claimed garment protector includes at least one stop on the zone of weakness. The stop, which is an area that is fully intact and is not part of the zone of weakness, protects the zone of weakness from inadvertently parting.

Applicant respectfully submits that independent claims 1-7, 53 and 54 are not obvious over Sachs, Lim, or LaRosa in view of DeMatteis et al. First, the Examiner has not pointed to

any suggestion or motivation for combining these references. The mere fact that references could be combined or modified is not sufficient to establish *prima facie* obviousness. The prior art must suggest the desirability of the combination of elements in order to render the combination obvious. No such suggestion is present in the references cited by the Examiner. In fact, the Examiner merely states "To have provided stops in the zone of weakness to prevent premature tearing would have been obvious in view of the teaching of DeMatteis et al." See Office Action at page 4. This is insufficient. See *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) (The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a *prima facie* case of obviousness was held to be improper). "The level of skill in the art cannot be relied upon to provide the suggestion to combine references." MPEP §2143.01.

Second, even if these references were properly combined, the combination does not teach or suggest every element of the claimed invention. Applicant respectfully asserts that the combination of references does not teach or suggest a garment protector with at least one zone of weakness along which the garment protector may be parted to separate the garment protector from the garment and at least one stop on the zone of weakness which protects the zone of weakness from inadvertently parting, as recited in amended claims 1-7 and in claims 53 and 54. Contrary to the Examiner's view of DeMatteis et al. as set forth in the Office Action, DeMatteis et al. does not teach or disclose, as recited in amended claims 1-7 and claims 53 and 54, "at least one zone of weakness along which the envelope may be parted to facilitate separating the garment protector from the garment, and at least one stop on the [vertical or diagonal] zone of weakness which protects the zone of weakness from inadvertently parting."

Instead, DeMatteis et al. teaches unsevered sections of bag material on the line of a cut,

which are left in place to form the material bridge which joins the body of the bag to a tab until the bag is completely severed. The tabs of many bags are fused together to form a packet of bags. The packet of bags is commonly the unitary mass that is manufactured at the same time and taken as a unit to a counter for serial dispensing. When an individual bag is separated from a group of such bags, separation occurs leaving the tabs behind. The bag disclosed in DeMatteis et al. is for grocery purposes and the disclosed zone of weakness is provided to separate the bag from a packet or stack of bags. The zone of weakness in DeMatteis et al., i.e., the line of cut separating the tab and the bag, is not used to sever or part the bag to reveal or obtain the contents within the bag as in the Applicant's claimed garment protector. Instead, the zone of weakness functions to separate the bag from a packet or stack of bags.

In addition, the unsevered sections of bag material are not stops which protect the zone of weakness from inadvertently parting to separate the grocery bag from its contents. Instead, they are connectors or bridges which join the body of the grocery bag to a tab or packet of bags. Referring to Figure 2 of DeMatteis et al., Tab T is defined by cuts 32 and 33. Between the cuts, a small and unsevered section of bag material 36 is allowed to remain. This unsevered portion of bag material is left in place when the bag is formed, and is the material bridge which joins the body of the bag to the tab. (See DeMatteis et al., Col. 4, lns. 25-37).

Applicant, therefore, contends that as the cited references do not teach or suggest the claimed subject matter recited in amended claims 1-7 and claims 53 and 54, Applicant's claimed invention clearly would not have been obvious over the references of record.

Similarly, Applicant asserts that the cited references do not teach or suggest a method of fabricating a garment protector by "forming at least one stop on the zone of weakness which protects the zone of weakness from inadvertently parting." Thus, amended claim 59 and 63 are

allowable over the cited references.

Applicant has also amended claim 67 to recite, in part, that the garment protector comprises "at least one stop on the zone of weakness which protects the zone of weakness from inadvertently parting." Applicant asserts that Schmidt does not teach or disclose a stop on the on zone of weakness as in the Applicant's claimed garment protector.

Claims 8-16 depend, directly and indirectly, from claim 1. Therefore, claims 8-16 include all of the limitations of claim 1. Because claim 1 is patentable over the cited art, it follows that claims 8-16 are also patentable for at least similar reasons, based on their dependency and the limitations within the claims.

Claims 18-22 depend from claim 2. Therefore, claims 18-22 include all of the limitations of claim 2. Because claim 2 is patentable over the cited art, it follows that claims 18-22 are also patentable for at least similar reasons, based on their dependency and the limitations within the claims.

Claims 24-28 depend from claim 3. Therefore, claims 24-28 include all of the limitations of claim 3. Because claim 3 is patentable over the cited art, it follows that claims 24-28 are also patentable for at least similar reasons, based on their dependency and the limitations within the claims.

Claims 30-34 depend from claim 4. Therefore, claims 30-34 include all of the limitations of claim 4. Because claim 4 is patentable over the cited art, it follows that claims 30-34 are also patentable for at least similar reasons, based on their dependency and the limitations within the claims.

Claims 36-40 depend from claim 5. Therefore, claims 36-40 include all of the limitations

of claim 5. Because claim 5 is patentable over the cited art, it follows that claims 36-40 are also patentable for at least similar reasons, based on their dependency and the limitations within the claims.

Claims 42-45 depend from claim 6. Therefore, claims 42-45 include all of the limitations of claim 6. Because claim 6 is patentable over the cited art, it follows that claims 42-45 are also patentable for at least similar reasons, based on their dependency and the limitations within the claims.

Claims 47-50 depend from claim 7. Therefore, claims 47-50 include all of the limitations of claim 7. Because claim 7 is patentable over the cited art, it follows that claims 47-50 are also patentable for at least similar reasons, based on their dependency and the limitations within the claims.

Claims 60-62 depend from claim 59. Therefore, claims 60-62 include all of the limitations of claim 59. Because claim 59 is patentable over the cited art, it follows that claims 60-62 are also patentable for at least similar reasons, based on their dependency and the limitations within the claims.

Claims 64-66 depend from claim 63. Therefore, claims 64-66 include all of the limitations of claim 63. Because claim 63 is patentable over the cited art, it follows that claims 64-66 are also patentable for at least similar reasons, based on their dependency and the limitations within the claims.

Applicant, therefore, respectfully requests reconsideration and withdrawal of the rejections under §103(a).

CONCLUSION

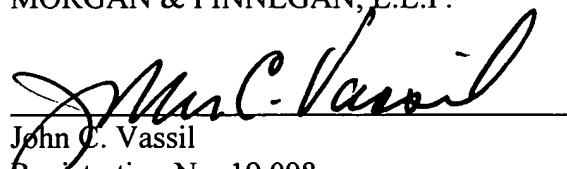
Based on the foregoing remarks, it is respectfully submitted that the claims as currently pending are patentable and in condition for allowance. Reconsideration of the application and withdrawal of the rejections are respectfully requested.

The Commissioner is hereby authorized to charge any additional fees which may be required for the timely consideration of this amendment under 37 C.F.R. §§ 1.16 and 1.17, or credit any overpayment to Deposit Account No. 13-4500, Order No. 0164-4015.

Respectfully submitted,
MORGAN & FINNEGAN, L.L.P.

Dated: February 13, 2003

By:


John C. Vassil
Registration No. 19,098

Correspondence Address:

MORGAN & FINNEGAN, L.L.P.
345 Park Avenue
New York, NY 10154-0053
(212) 758-4800 Telephone
(212) 751-6849 Facsimile

**APPENDIX WITH MARKINGS TO SHOW CHANGES MADE
IN THE SPECIFICATION**

Please AMEND the second paragraph on page 8, beginning at line 13, as follows:

In a further embodiment of the present invention, [there exists] a plurality of zones of weakness are provided on the polyethylene garment protector. Figure 3 illustrates the [subject] polyethylene garment protector (15) with two vertical and parallel zones of weakness (65, 70). The zone of weakness on the left side (65) is illustrated as minute perforations, and the zone of weakness on the right side (70) is illustrated as a strip of material which is less resistant to tearing than the adjacent material from which the envelope is made. Indeed, as illustrated in Figure 3, multiple types of zones of weakness may exist on one garment protector. In addition, the [The] zone of weakness on the right side (70) extends partially along the length of the garment protector, thus illustrating that the zones of weakness need not span the entire length of the garment protector. While Figure 3 depicts only two zones of weakness (65, 70) on one side of the garment protector, it shall be understood that the polyethylene garment protector (15) may have one or more zones of weakness either on one side or on both sides of the polyethylene garment protector (15). In a preferred embodiment of the invention, the zones of weakness exist on both sides of the polyethylene garment protector (15) in exactly the same location; that is, both sides of the garment protector are mirror images of one another.

IN THE CLAIMS

Please DELETE claims 17, 23, 29, 35, 41, 46 and 51.

Please AMEND claims 1-7, 52, 55, 59, 63 and 67 as follows:

1. (Amended) A garment protector comprising:

an elongated envelope to be disposed about a garment, said envelope having a front side and a back side, [and]

at least one zone of weakness on either one or both sides along which said envelope may be parted to facilitate separating the garment protector from [and] the garment, and

at least one stop on the zone of weakness which protects the zone of weakness from inadvertently parting.

2. (Amended) A garment protector comprising:

an elongated envelope to be disposed about a garment, [and]

at least one vertical zone of weakness extending substantially along the entire vertical length of the envelope along which said envelope may be parted to facilitate separating the garment protector from [and] the garment, and

at least one stop on the vertical zone of weakness which protects the zone of weakness from inadvertently parting.

3. (Amended) A garment protector comprising:

an elongated envelope to be disposed about a garment suspended upon a hanger, the upper end of said envelope having an opening at the apex for a suspension element of said hanger, wherein said envelope has a front side and a back side, [and]

at least one vertical zone of weakness on either the front side or back side along which said envelope may be parted to facilitate separating the garment protector from [and] the garment, and

at least one stop on the vertical zone of weakness which protects the zone of weakness

from inadvertently parting.

4. (Amended) A garment protector comprising:

an elongated envelope to be disposed about a garment suspended upon a hanger, the upper end of said envelope having an opening at the apex for a suspension element of said hanger, wherein said envelope has a front side and a back side, [and]

at least one vertical zone of weakness on both the front side and back side along which said envelope may be parted to facilitate separating the garment protector from [and] the garment, and

at least one stop on the vertical zone of weakness which protects the zone of weakness from inadvertently parting.

5. (Amended) A garment protector comprising:

an elongated envelope to be disposed about a garment suspended upon a hanger, the upper end of said envelope having an opening at the apex for a suspension element of said hanger, wherein said envelope has a front side and a back side, [and]

at least one diagonal zone of weakness on both the front side and back side along which said envelope may be parted to facilitate separating the garment protector from [and] the garment, and

at least one stop on the diagonal zone of weakness which protects the zone of weakness from inadvertently parting.

6. (Amended) A garment protector comprising:

an elongated envelope to be disposed about a garment suspended upon a hanger, the

upper end of said envelope having an opening at the apex for a suspension element of said hanger, wherein said envelope has a front side and a back side, [and]

at least one vertical zone of weakness, extending substantially along the entire vertical length of said envelope, on both the front side and back side along which said envelope may be parted to facilitate separating the garment protector from [and] the garment, wherein said at least one zone of weakness is a perforated line, and

at least one stop on the vertical zone of weakness which protects the zone of weakness from inadvertently parting.

7. (Amended) A garment protector comprising:

an elongated envelope to be disposed about a garment suspended upon a hanger, the upper end of said envelope having an opening at the apex for a suspension element of said hanger, wherein said envelope has a front side and a back side, [and]

at least one vertical zone of weakness, extending substantially along the entire vertical length of said envelope, on both the front side and back side along which said envelope may be parted to facilitate separating the garment protector from [and] the garment, wherein said at least one zone of weakness comprises a strip of material which is less resistant to tearing than adjacent material from which said envelope is made, and

at least one stop on the vertical zone of weakness which protects the zone of weakness from inadvertently parting.

52. (Amended) A garment protector comprising:

an elongated envelope to be disposed about a garment said envelope having a front side and a back side,

at least one vertical zone of weakness, extending substantially along the entire vertical length of said envelope, on both the front side and back side along which said envelope may be parted to facilitate separating the garment protector from [and] the garment, [;] and

at least one stop on the vertical zone of weakness which protects the zone of weakness from inadvertently parting [opening].

55. (Amended) A method of fabricating [the] a garment protector [of claim 1], comprising:

forming by tubular extrusion an elongated envelope to be disposed about a garment, the envelope having a front side and a back side,

generating at least one zone of weakness on either one or both sides extending along a length of the elongated envelope, and [garment protector]

forming at least one stop on the zone of weakness which protects the zone of weakness from inadvertently parting.

59. (Amended) A method of fabricating [the] a garment protector [of claim 53], comprising:

forming by tubular extrusion an elongated envelope to be disposed about a garment suspended upon a hanger,

forming an opening at the apex of the envelope for a suspension element of the hanger,

forming a pair of inclined seams at the upper part of the envelope which substantially seal the envelope and permit the envelope to conform loosely to a shape of the enclosed garment,

generating at least one vertical zone of weakness extending along a vertical length of the

elongated envelope [garment protector], and

forming at least one stop on the vertical zone of weakness which protects the zone of weakness from inadvertently parting.

63. (Amended) A method of fabricating a [the] garment protector [of claim 54], comprising:

forming by tubular extrusion an elongated envelope to be disposed about a garment suspended upon a hanger,

forming an opening at the apex of the envelope for a suspension element of the hanger,
forming a pair of inclined seams at the upper part of the envelope which substantially seal the envelope and permit the envelope to conform loosely to a shape of the enclosed garment,

generating at least one diagonal zone of weakness extending along a length of the elongated envelope [garment protector], and

forming at least one stop on the diagonal zone of weakness which protects the zone of weakness from inadvertently parting.

67. (Amended) A garment protector comprising:

a sealed envelope to enclose a folded garment or textile, said envelope having a front side and a back side, [and]

at least one zone of weakness on either one or both sides along which said sealed envelope may be parted to facilitate separating the garment protector from [and] the enclosed garment or textile, and

at least one stop on the zone of weakness which protects the zone of weakness from

inadvertently parting.